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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,892	07/24/2003	Craig Jay Graham		2557
43793	7590	06/15/2006		
EVEREST INTELLECTUAL PROPERTY LAW GROUP P. O. BOX 708 NORTHBROOK, IL 60065				
			EXAMINER HECKENBERG JR, DONALD H	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,892

Applicant(s)

GRAHAM ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 37 and 39-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-11, 14, 15, 18, 20, 21, 24-36 and 38 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 16, 17, 19, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. Applicant's election of Group I and Specie A (readable on claims 1-5, 9-36, and 38) in the reply filed on 17 May 2006 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. The beginning of the specification refers to a "Disclosure Document" filed on 12 June 2003. An I.D.S. filed by Applicant on 22 September 2003 also references the same disclosure document. The file wrapper of the instant application, however, does not appear to contain a copy of the referenced document, nor does the I.D.S. contain a PTO 1449 to indicate consideration of the document. Applicant is requested to review there records and if file a copy of the document along with a PTO 1449 if they desire the document to be considered and officially made of record.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 9, 18, 20 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollard et al. (U.S. Pat. No. 5,766,385).

Pollard discloses a method of making a fastener structure. Included is a component (30) acting a shim within a mold (see Fig. 1). The shim component is constructed from a plurality of layers (30i, 30t and 30o) of a plurality of nonmagnetic materials, including plastic (see cl. 7, l. 46 - cl. 8, l. 5), and the sides of the component have a curved shape (Fig. 1). One of the layers (30i) acts as a sealing gasket against a perform (16) used within the molding process.

Claim 1 of the instant application refers to a particular use of the claimed mold shim device. Specifically, one side of the mold shim is defined as being "adapted for placement on the interior surface of a forming mold," the second side is "adapted for placement under a fastener strip to be in-molded," and the shim "compensates for variability in [the] interior surface of the forming mold and provides an even sealing surface for [the] fastening strip." It is well settled that the intended use of a device is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing

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the claimed use, then it meets the claim limitations. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. Further, a device must be distinguished from the prior art in terms of structure rather than function; that is, a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art teaches all the structural limitations of the claim. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); MPEP 2114. In the instant case, Pollard discloses a shim component for use in a molding apparatus, with the component containing all of the structure defined in claims of the instant application. As such, Pollard anticipates the recited shim device, regardless of the specifically defined uses in the claims.

5. Claims 1, 2, 5, 9 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Oborny et al. (U.S. Pat. No. 5,766,723).

Oborny discloses a fastener assembly and a method of making such. The method includes the use of a foam shim structure

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(135) used in within a mold (see Figs. 3A, 3B, 4A and 4B; cl. 6, ll. 40-43). As evidence in Fig. 2, the shim structure is rectangular with a slot disposed along the longitudinal dimension.

As noted above in the rejection in view of Pollard, the uses of the claimed shim is not germane to its patentability. As Oborny discloses a shim device with all of the claimed structural features, the reference anticipates the claims regardless of the recited uses.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mabee (U.S. Pat. No. 5,603,395).

Mabee discloses an electrically actuated disc stack. Within the device, a shim (500) is used, the shim being made of non-magnetic stainless steel (cl. 16, ll. 19-22).

As noted above in the rejection in view of Pollard, the uses of the claimed shim is not germane to its patentability. In this case, Mabee discloses a shim with all of the physical structure recited in claims 1-3 of the instant application. Mabee's shim could further be used within a mold apparatus and process, and thus, anticipates the claims, regardless of the more specifically defined uses of the claims.

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7. Claims 1, 27-29, 31-35 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Banfield (U.S. Pat. No. 5,786,061).

Banfield discloses a separable fastener and a method for a further structure incorporating the fastener. As shown in Figs. 4A, 4B, and Fig. 6, Banfield uses a structure (413) which acts as a shim against a mold within a the process of making the structure incorporating the fastener. Banfield further discloses the shim structure to include a side with either a convex or concave shape (see Figs. 2C and 2D).

As noted above in the rejection in view of Pollard, the uses of the claimed shim is not germane to its patentability. As Banifeld discloses a shim device with all of the claimed structural features, the reference anticipates the claims regardless of the recited uses.

With respect to claim 31, a "means for releasably engaging a first object" is recited in line 5. This element has been interpreted as invoking 35 U.S.C. § 112, sixth paragraph, and thereby limited to the corresponding structure described in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994); MPEP § 2181. The specification of the instant application defines the means as a clip engaging member or wire engaging member (see for

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example, p. 20, ll. 9-13). Note, however, the actual structure engage by the engaging means, for example a specific clip or wire, is related to the use of the claimed mold shim with releasable engaging means.

The shim component disclosed by Banfield can further can further be interpreted as including an extended surface (400) to which a plurality of arrow shaped engaging members (648) are attached (see Fig. 6). The engaging members could act to connect to a wire or clip structure. As such, the structure disclosed by Banfield further anticipates claims 31-35 and 38.

8. Claims 1, 2 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al. (U.S. Pat. No. 4,842,916).

Ogawa discloses a separable fastener component and moldings attached with such a fastener component. In disclosing a process for making the fastener component, Ogawa includes a shim structure (4) used within a mold (see Fig. 3b). In some embodiments, the shim includes a cap formed on one wall extending downward edge on one side of the shim (see Fig. 5(e)).

As noted above in the rejection in view of Pollard, the uses of the claimed shim is not germane to its patentability. As Ogawa discloses a shim device with all of the claimed

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structural features, the reference anticipates the claims regardless of the recited uses.

9. Claims 1, 10, 11, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Billarant (U.S. Pat. No. 6,148,487).

Billarant discloses method of manufacturing molded articles. Billarant includes a shim structure (6) used within a mold (see Fig. 1). The shim includes posts (7, 8 and 9) extending along the longitudinal and end edges.

As noted above in the rejection in view of Pollard, the uses of the claimed shim is not germane to its patentability. As Billarant discloses a shim device with all of the claimed structural features, the reference anticipates the claims regardless of the recited uses.

10. Claims 31, 32, 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Cloutier et al. (U.S. Pat. App. Pub. No. 2002/0066976).

Cloutier discloses a mini-ball insertion mechanism for forming golf ball cores. The mechanism includes a structure (10 and 30) functioning a shim within a mold (see Fig. 5). In one embodiment, the shim includes a releasable engaging means that

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comprises a magnet in order to hold objects against the shim (see paragraph 23).

Note the above discussion with respect to the intended use of the claimed mold shim applies with respect to claims 31, 32, 36 and 38 in view of Cloutier as well. For example, the releasable engaging means disclosed by Cloutier could engage a wire in a molding operation. Cloutier therefore anticipates claims 31, 32, 36 and 38 regardless of the recited uses in the claims.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 24-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Billarant in view of Di Pinto (U.S. Pat. No. 3,127,457).

Billarant discloses the mold shim structure as described above. Billarant does not disclose a non-stick film or coating on the surface of the shim. Such coatings, however, are well known in the art. Di Pinto, for example, discloses the uses polytetrafluoroethylene films or coatings on mold surfaces for

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the purpose of aiding in release of the molded product from the mold surface. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device disclosed by Billarant as such to further include a non-stick film or coating on the shim surfaces because this would aid in release of the molded product from the shim as suggested by Di Pinto.


15. Claims 12, 13, 16, 17, 19, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (571) 272-1316. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Primary Examiner
A.U. 1722

6-12-6